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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,300	02/08/2001	Peter Kwasny	KWASNY-2	4557

7590 12/06/2001  
COLLARD & ROE, P.C.  
1077 Northern Boulevard  
Roslyn, NY 11576

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 12/06/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

MF-2

**Office Action Summary**

Application No.

09/779,300

Applicant(s)

PETER KWASNY

Examiner

Judy M. Reddick

Art Unit

1713

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 February 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Priority**

- 1) ***Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.***

**Claim Rejections - 35 USC § 112**

***The following is a quotation of the second paragraph of 35 U.S.C. 112:***

***The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.***

- 2) ***Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***
- A) ***The recited "paint material comprising HS (high solid) acrylic resins" per claim 1 constitutes indefinite subject matter as per it not being readily ascertainable if applicant intends more than 1 acrylic resin or only one acrylic resin to be contained in the paint material.***
- B) ***The recited "mean molecular weight" per claim 1 and "average molecular weight" per claims 2 and 4-6 constitute indefinite subject matter as per it not being readily ascertainable as to the exact entity intended to qualify the recited molecular weight, i.e., "weight average" or "number average", the two being substantially different as taught in any basic polymer text book.***
- C) ***The recited "high solid(s)" per claim 1, "medium solid(s)" per claim 4 and "low solid(s)" per claim 6 constitute indefinite subject matter as per the metes***

*and bounds of "high", "medium" and "low" engender an indeterminacy in scope, said terms being relative and not absolute.*

*D) The recited "polyisocyanates" per claims 1, 4 and 6 constitutes indefinite subject matter as per reasons stated in item A) supra.*

*E) The recited "about 75:25 to 70:30" per claims 1, 4 and 6 constitutes indefinite subject matter as per it not being readily ascertainable as to whether the "about" is intended to qualify the firstly recited ratio only or the entire ratio range.*

*F) The recited "propane/butane" per claim 1 constitutes indefinite subject matter as per, in this instance, it is not clear if applicant intends the "/" to engender propane, butane or a mixture thereof.*

*G) The recited "low component of styrene" per claim 4 constitutes indefinite subject matter as per the metes and bounds of "low" engender an indeterminacy in scope.*

**Claim Rejections - 35 USC § 103**

**3) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

**4) The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:**

- 1. Determining the scope and contents of the prior art.**
- 2. Ascertaining the differences between the prior art and the claims at issue.**
- 3. Resolving the level of ordinary skill in the pertinent art.**
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.**

**5) Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gormley et al* (U.S. 5,853,700).**

***Gormley et al* disclose aerosol spray compositions defined basically as containing a) a block copolymer, b) 1-15 wt.% of a film-forming resin which includes a hydroxyl-functional acrylic resin containing n-tert-octyl acrylamide, methyl and/or ethyl methacrylate, hydroxyl propyl methacrylate, acrylic acid and t-butyl aminoethyl methacrylate, c) up to 70 wt.% of a solvent, d) 10 to 60 wt.% of a propellant which includes propane and/or butane and e) 0.1 to 10 wt.% of other conventional adjuvants sufficient to meet the claimed hardener. See, e.g., the Abstract, cols. 2-6 and the claims of *Gormley et al*.**

**The disclosure of *Gormley et al* differs basically from the claimed invention as per the non-express disclosure of an embodiment directed to the use of the hydroxyl-functional acrylic resin. However, one having ordinary skill in the art would have found it obvious to use the hydroxyl-functional acrylic resin as the film-forming resin in formulating the composition of *Gormley et al* as per such having been within the purview of the general disclosure of *Gormley et al* and with a reasonable expectation of success. Criticality for**

*such, commensurate in scope with the claims, not having been demonstrated on this record.*

*While the hydroxyl-functional acrylic resin of Gormley et al is generic, such necessarily implies that any hydroxyl-functional acrylic resin, including the claimed hydroxyl-functional acrylic resin, would have been operable within the scope of patentees invention and with a reasonable expectation of success.*

*The manner in which the components are mixed is immaterial as provided for under the auspices of In re Thorpe(227 USPQ 964).*

#### **Conclusion**

*6) Note the attached PTOL FORM-892 for additional prior art cited as of being illustrative of the general state of the art.*

*7) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703) 308-4346. The examiner can normally be reached on Monday-Friday, 6:30 A.M.-3:00 P.M..*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wu David can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3599 for regular communications and (703) 305-3599 for After Final communications.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2381.*

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*JMR jmb*  
**December 2, 2001**

*J. M. Reddick*  
JUDY M. REDDICK  
PRIMARY EXAMINER